

16. (Original) The method of claim 15, wherein enabling the voltage regulator to provide Vcc to the processor includes electrically coupling a Vcc output of the voltage regulator to a Vcc input of the processor.

A1
end

17. (Original) The method of claim 15, wherein enabling the voltage regulator to receive the control signal from the processor includes electrically coupling a Vcc control output of the processor to a Vcc control input of the voltage regulator.

18. (Canceled)

REMARKS/ARGUMENTS

The foregoing amendment and the following arguments are provided to impart precision to the claims, by more particularly pointing out the invention, rather than to avoid prior art.

35 U.S.C. § 102(b) Rejections

Examiner rejected claims 1-3, 6-11, 13 and 15-17 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,440,520 (hereinafter "Schutz").

Examiner rejected claims 4, 12, and 18 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,440,520 (hereinafter "Schutz") as applied to claims 1-3, 6-11, 13 and 15-17 above, and further in view of European Patent No. 0632360A1 (hereinafter "Welser").

Applicant's independent claims 1, 9, and 15 have been amended to include the limitations of dependent claims 4, 12, and 18, respectively.

Applicants respectfully submit that it would not have been obvious to modify to Schutz to include lowering the target value of the supply voltage if the circuit/processor is inactive, in view of Welser as suggested by examiner, because there would have been no reasonable expectation of successfully modifying Schutz. (See Manual of Patent Examining Procedure ¶ 2143.02; See also *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976), and *Ex parte Erlich*, 3 USPQ2d 1011 (Bd. Pat. App. & Inter. 1986).

In particular, neither Schutz nor Welser includes an enabling description of how to detect the circuit/processor is inactive and adjust the target value of the supply voltage accordingly, as claimed by applicant. Therefore, there would be no reasonable expectation of successfully modifying Schutz to include lowering the target value of the supply voltage if the circuit/processor is inactive.

Furthermore, the mere fact that a reference can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the modification or combination. *In re Mills*, 916 F.2d 80, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claim, there must be a suggestion or motivation in the reference to do so." *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990). (See also MPEP 2143.01).

In the present matter, Schutz is not capable of being modified to include lowering the target value of the supply voltage if the circuit/processor is inactive, and as such, there is clearly not suggestion or motivation in Schutz nor Welser to do so.

In addition, a statement that modifications of the prior art to meet the claimed invention would have " 'well within the ordinary skill of the art at the time claimed invention was made' " because the references relied upon teach that all aspect of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine or modify the teachings of the reference. *Ex Parte Levensgood*,

28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000). (MPEP 2143.01).

CONCLUSION

Applicants respectfully submit the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call John Ward at (408) 720-8300, x237.

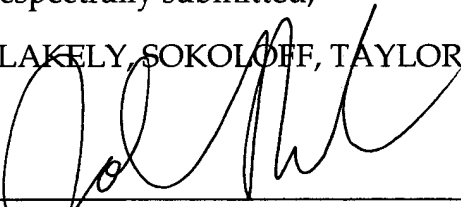
Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Date: _____

1/14/04



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